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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,755	01/27/2004	Tian-An Liou	LP4001-3839	8768

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TIAN-AN LIOU  
235 Chung-Ho  
Box 8-24  
Taipei,  
TAIWAN

EXAMINER

STASHICK, ANTHONY D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/764,755

Applicant(s)

LIYOU, TIAN-AN

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 4 contain the phrase “thenar portion” which renders the claims vague and indefinite. Although applicant can be their own lexicographer, applicant cannot use reference terms that are contrary to their usual meaning. Applicant fails to describe what applicant considers the “thenar portion”. Since it is well known that the thenar is the region at the base of the thumb on the palm of the hand, it is unclear what applicant is calling the “thenar portion”. The palm of the hand does not specifically translate to the plantar surface of the foot. It appears that what applicant is referring to is the ball of the big toe, but applicant fails to describe this in any way in which it could be determined in the specification.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 4 is rejected under 35 U.S.C. 102(b) as being anticipated by WO 94/09661. WO ‘661 discloses all the limitations of the claim including the following: an air ventilating shoe sole

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2, 3 comprising a shoe sole base; a main ventilating groove (see Figure 1 on outside portion of the shoe sole) of a shape of a capital omega on a top surface of the shoe sole base (See Figure 1, omega is defined by the area near 8 or 5 on the sole, around the front of the foot (or heel of the foot) and back to the other of 8 or 5); a plurality of transverse recesses (see Figure 1 between pods 19) on a portion of the surface of the shoe sole base corresponding to the ball of the foot (thenar?) portion and the arch portion of a foot (see Figure 1); a pair of flanges (including 7 and 10) respectively extending uprightly from two lateral sides of the shoe sole base (see Figure 1); an inner wall of each of the flanges being provided with a plurality of elongated air-circulating chambers (see Figure 1, chambers shown in 10); a bottom end of each of the air-circulating chambers being connected to a leg of the main ventilating groove (see Figure 1); a top end of each of the air-circulating chambers is provided with a vent hole (vent holes in 9, 10 and 6, 7).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carolin 1,211,542 in view of WO 94/09661. Carolin '542 discloses all the limitations substantially as claimed including the following: a shoe sole base; an X-shaped ventilating groove on a top surface of the shoe sole base; a plurality of transverse recesses on a portion of the top surface of the shoe sole base corresponding to the ball of the big toe (thenar?) portion and an arch portion of a foot; a pair of main ventilating grooves crossing the transverse recesses to form an air

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passage net; rear ends of the main ventilating grooves being connected to a front end of the X-shaped ventilating groove; vent holes C allow warm air inside the shoe the sole is attached to and ambient air can exchange; positions of the vent holes can effectively prevent inward permeation of water; the shoe sole will not influence the outlook and comfort of the shoe; there is one air-circulating chamber (K at forefoot area); there are two air circulating chambers (both Ks in Figure 5). Carolin '542 does not disclose the flanges and the particulars related to the flanges. WO '661 teaches that flanges (attached with 8 and 5) can be vertically extending from the rear of the shoe sole base (see Figure 1) and that each of these flanges can have a pair of elongated air-circulating chambers (see portion 9). Furthermore, WO '661 teaches that the bottom ends of the air-circulating chambers are connected to the rear end of the X-shaped groove (notice location of flanges in WO '661 and translate it to Carolin '542 in the same position, this places them at the rear of the X-shaped groove.) The flange of WO '61 include a pair of ventilating holes (see 6) disposed in an upper portion thereof with the vent holes going through the upper ends of the air-circulating chambers. These flanges allow for air to enter into the shoe, be filtered, and exit the shoe without allowing water to enter the shoe. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place flanges, such as those taught by WO '661, on the sole structure of Carolin '542 to aid in filtering the air used in the shoe while still preventing water from entering the shoe. With respect to claim 5, Carolin '542 teaches that there can be an air-ventilating channel, having a front end connected to the main ventilating grooves (see sides of boot in Figure 3) formed on the top surface of the sole base, and a rear end connected to the flange (since the flange of WO '661 would be located in the side of the boot upper), the air-circulating chambers being two air passages (the passages B) formed through a U-

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shaped frame (the strips A that form the individual tubes and the bottom of the outer cover) divided by a central vertical partition strip (the center strip A dividing the passages B) with the U-shaped frame enclosing a rear exit of the air ventilating channel (see Figure 1 of Carolin '542). Carolin '542 also discloses a cover D attached to the boot side to isolate the rear exit of the air-ventilating channel from the outside and connecting the vent holes to the two air passages.

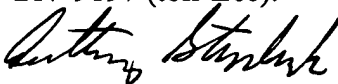
### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Anthony Stashick

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Primary Examiner  
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ADS